

REMARKS

Claims 1-20, 23, 24, 27 and 28 which are directed to temporarily protecting a portion of a surface which is to be coated are currently pending. Claims 21, 22, 25 and 26 which are directed to compositions useful in such method have been withdrawn.

The Examiner has withdrawn his objections to the Title and the Abstract and to claims 9, 10, 12, 20 and 24 under 35 USC 112, second paragraph.

The Examiner has withdrawn his rejection of claims 1-4, 6, 7, 9-14, 16, 17, 19 and 20 under 35 USC 102(b) and claims 5, 8, 15, 18, 23 and 24 under 35 USC 103(a).

The Applicants thank the Examiner for reconsidering and withdrawing the above objections and rejections.

The Examiner has now rejected newly added claims 27 and 28 under 35 USC 112, first paragraph, for failure to comply with the written description requirement. The Examiner argues that these newly added claims recite that the masking composition is removed 'solely with water'. Since Applicant has not specifically defined 'solely', the Examiner has interpreted this term according to its ordinary meaning: 'without another; to the exclusion of all else'. (The Examiner cites *Merriam-Webster's Collegiate Dictionary, 10th Edition, © 1998 by Merriam Webster, Inc.*, p. 1118). As agreed by the Examiner, the originally-filed disclosure discloses that the masking composition may be removed by ordinary or pressure washing with "water". The Examiner argues that the limitation 'solely with water' reads on washing

with absolutely nothing other than pure H₂O - this excludes tap water and even distilled and de-ionized water because such can contain things other than H₂O (if only dissolved O₂ or N₂ from the air). (Emphasis added) "This degree specificity is not supported by the originally-filed disclosure."

The Applicants disagree with the Examiner's extremely restricted interpretation of the term "water". As stated at lines 4-9, of page 13 of the specification, the masking composition is preferably removed by normal washing with water since the masking material is easily miscible or soluble in water. This may be contrasted removing the coating by mechanical means such as peeling or scraping or washing with organic solvents or soap solutions. It is clear that in the context of removing a masking material by washing with water, it would be understood by one of ordinary skill in the art that pure water, i.e. water, without even dissolved gases, was not intended by the Applicants.

Thus, it is believed that the term "solely with water" would convey to one skilled in the art, that one could practice the invention as defined in claims 27 and 28 by washing with water alone and not with a solvent, or solvent-water mixture or water surfactant solution.

The Examiner has rejected claims 19, 27 and 28 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner points out that with respect to claim 19, there is insufficient antecedent basis for the term "said polymer" in the claim. The

Applicants have amended claim 19, as suggested by the Examiner to overcome this rejection.

The Examiner has also rejected claims 27 and 28 under 35 USC 112, second paragraph, arguing that "these claims recite removing the masking coating 'solely with water'. As noted above, this limitation excludes anything in addition to pure water, including pressure. The specification, at p. 13, discloses that the masking coating may be removed by pressure washing. Applicant, consequently, appears to utilize the term 'solely' in a fashion contrary to its ordinary meaning."

Again, it is believed that, in view of the conditions under which one of ordinary skill in the art would understand that the invention is being practiced, being too restrictive in limiting the term "solely with water" to exclude everything except pure water and now pressurized water. As stated above, the term "solely with water" would be understood in the context of the art to mean water, without solvents or surfactants since this is how a masking composition is removed. The Applicants have pointed out the advantage of removing the masking material with water, alone, throughout the specification.

For example, at lines 22-24 of page 4 of three specification, the polymer utilized in the masking material is preferably "a water-soluble acrylic acid or methacrylic acid-containing copolymer".

At lines 29-33 of page 6 of the specification, the masking material is "removed easily from the surface to be protected after use with a water wash".

At lines 7-9 of page 7 of the specification, the coating may be removed from the surface by "simply washing with water".

At lines 11-13 of page 14 of the specification, the coating is "easily removed by the application of pressurized water".

Furthermore, the advantage of avoiding the use of solvents in the method of the invention, including the step of removal of the masking composition by washing with water is discussed at lines 11-21 of page 11 of the specification.

In view of the above, it is believed that the term "solely with water" is not indefinite and would be understood to include washing with pressurized water and washing with water in the absence of surfactants and solvents.

The Examiner has rejected claims 1, 2, 11, 12, 23, and 24 under 35 USC 102(b) as being anticipated by Van Winckel (US 5,618,582 A).

Van Winckel teaches a method for temporarily protecting a portion of a surface that is to be coated with a coating compound.

The Examiner argues that Van Winckel teaches that the masking material may be an aqueous acrylic emulsion and that "the term 'acrylic' is inclusive of polymers or copolymers of (meth)acrylic acid as well as esters of these acids. It is, therefore, the Examiner's position that Van Winckel's teaching of an 'acrylic' emulsion is inclusive of a carboxylic acid-containing polymer and, with respect to claims 23 and 24 copolymers of (meth)acrylic acid and (meth)acrylic acid esters."

It is believed that the Examiner is incorrect. While the term "acrylic" includes polymers or copolymers of (meth)acrylic acid, it also includes polymers and copolymers having no carboxylic acid groups. That is, the term acrylic includes ethylacrylate homopolymer which by definition does not include carboxylic acid groups. Therefore, a critical limitation of the invention, as defined in claims 1, 2, 11, 12, 23 and 24, i.e., the presence of carboxylic acid groups or methacrylic acid, specifically, is not found in Van Winckel. In addition, the requirement that copolymer of claims 23 and 24 is a copolymer of ethylacrylate and methacrylic acid, is not disclosed by Van Winckel. A reference not disclosing a critical limitation of the claimed invention cannot anticipate the invention.

The Examiner has rejected claims 1-3, 6, 7, 9-13, 16, 17, 19, and 20 under 35 USC 103(a) as being unpatentable over Van Winckel (US 5,618,582 A) in view of Roberts (US 5,453,459 A).

The Examiner agrees that while Van Winckel teaches that the masking material may be an acrylic emulsion it does not teach the specific composition claimed by Applicant.

The Examiner argues that "Roberts teaches a masking material composition for temporarily protecting a surface from a coating." (Emphasis added) The Applicants have carefully reviewed the reference and disagree that Roberts suggests that the disclosed compositions which comprise an aqueous dispersion of a film-forming acrylic polymer or copolymer and an acetylenically unsaturated nonionic surfactant, may be used as a masking composition. Therefore, it is believed that there is no motivation to substitute the acrylic polymers or copolymers in

the method of Van Winckel. Moreover, despite the fact that the Examiner argues that in the Roberts reference "(t)he acrylic polymer can be a polymer or copolymer of acrylic acid, or an acrylate; preferably a partially neutralized acrylic acid copolymer" there is no suggestion that the acrylic copolymer of the masking material can be neutralized and solubilized as claimed in claims 6, 7, 16 and 17. Thus, even if the Examiner is correct in his argument that the invention, as claimed, is obvious in view of the combination of Van Winckel and Roberts, in certain claims, claims 6, 7, 16 and 17 are clearly patentable since Roberts does not disclose a copolymer that is solubilized by the added alkali.

The Examiner argues that "Van Winckel teaches that the masking material composition may be an acrylic emulsion, but places no further limitation thereon, one of ordinary skill in the art would have looked to the prior art to find a suitable acrylic emulsion composition for masking a surface to protect it from unwanted application of a coating composition. Consequently, it would have been obvious to one of ordinary skill in the art to modify the method of Van Winckel so as to apply, as the acrylic emulsion masking composition, the composition of Roberts. However, as noted above, Roberts does not suggest that his acrylic copolymers can be utilized in the masking process of Van Winckel.

The Examiner specifically notes, in rejecting claims 27 and 28, "it is the Examiner's position that pressurized water washing is a well-known expedient to removing protective coatings from surfaces and it would, therefore, have been obvious to one of ordinary skill in the art to utilize such a method to remove the coating of Van Winckel in view of Roberts.

As noted above, pressurized water washing appears to be encompassed by applicant's definition of 'solely with water'."

However, Roberts specifically disclosed that the acrylic copolymers of his invention with an alkaline aqueous medium, e.g., a stripping solution comprising a dialkylaminoalkanol. [See column 5, lines 49 through 66 of Roberts] In fact, Roberts points out that his coatings are not effected by water alone. (See column 10, lines 15 through 24 and Table 2 of Roberts).

The Examiner has also rejected certain claims for obviousness under 35 USC 103(a) over the aforesaid combination of Van Winckel and Roberts, further in view of a third reference.

Claims 5 and 15 are further rejected over Zajac, which discloses the EDTA limitation of said claims in combination a similar acrylic acid copolymer.

Claims 8 and 18 are further rejected over Maxwell which the Examiner cites to show that it is known in the art that the viscosity of acrylic resins may be adjustable. Moreover, it is clear that Maxwell discloses a viscosity range of 30-1500 cps which slightly overlaps but is substantially lower than the range of claims 5 and 15 (See column 4, lines 60-63 of Maxwell.) Applicants point out at page 8, lines 11-26 of the specification that viscosity is important. That is, the viscosity must be "low enough to permit application to and continues coating of the surface." But the coating must include sufficient solids, i.e. a minimum viscosity, to form a "continuous protective coating when dried." Claim 4 and 14 are further rejected over Ely to show that it is known to protect glass portions of a

motor vehicle from unwanted paint application by selective application of a removable masking composition. For the reasons set forth above, it is believed that the combination of Van Winckel and Roberts is deficient. Therefore, the addition of this third reference does not make these claims obvious under 35 USC 103(a).

Moreover, Ely discloses that the masking composition is polyvinylalcohol not an acrylic copolymer.

The Examiner has added Kawabata to the above combination of Van Winckel, Roberts and Zajac to hold claims 23 and 24, which include the limitation that the polymer comprising the masking composition is a copolymer of methacrylic acid and ethyl acrylate, as obvious under 35 USC 103(a).

For the reasons set forth above, it is believed that the combination of Van Winckel and Roberts is deficient. Therefore, the addition of Zajac and/or Kawabata does not make these claims obvious under 35 USC 103(a).

The Examiner has rejected claims 6-10, 16-20, 27 and 28 under 35 USC 103(a) as being unpatentable over Van Winckel (U.S. 5,618,582 A).

The Examiner argues that "the pH, viscosity, and relative proportions of resin components are all result-effective variables determining the final properties of the masking composition. Absent clear and convincing showings of unexpected results demonstrating the criticality of the claimed ranges, it would have been obvious to one of ordinary skill in the art to

optimize such result-effective variables by routine experimentation".

The Examiner has not made out a *prima facie* case that selecting a pH, which is sufficient to neutralize and solubilize the polymer as set forth in claims 6, 7, 16 and 17 is obvious, since it is clear that Van Winckel does not teach that the acrylic copolymer disclosed therein would be soluble at any pH. Therefore, Applicant is not obligated to provide unexpected results as the Examiner has not made out the *prima facie* case. The same is true as to viscosity as Van Winckel does not disclose the viscosity limitation of claims 8 and 19.

The Examiner argues that with respect to claims 27 and 28, "it is the Examiner's position that pressurized water washing is a well-known expedient to removing protective coatings from surfaces and it would therefore, have been obvious to one of ordinary skill in the art to utilize such a method to remove the coating of Van Winckel in view of Roberts. As noted above, pressurized water washing appears to be encompassed by Applicant's definition of 'solely with water'." However, as pointed out above, Roberts' acrylic copolymers are resistant to water and must be removed with an alkaline stripping solution.

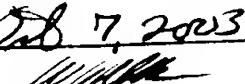
It is believed, in view of the above, all of the claims are in condition for allowance. Therefore, the Examiner is asked to reconsider and withdraw his rejection and pass the claims to issue.

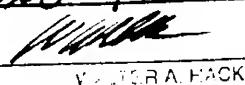
Respectfully submitted,



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